

REMARKS

I. General

The issues outstanding in the instant application are as follows:

- Claims 1, 2, 4-6, 19, 19 and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeZorzi*, U.S. Pat. No. 6,232,875(hereinafter *DeZorzi*), in view of *Rosenberger*, U.S. Pat. No. 4,947,151 (hereinafter *Rosenberger*);
- Claims 3 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeZorzi* and *Rosenberger*, in view of Hughes et al, U.S. Pat. No. 5,557,268 (hereinafter *Hughes*);
- Claims 3 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeZorzi* and *Rosenberger*, in view of Hughes et al, U.S. Pat. No. 5,557,268 (hereinafter *Hughes*);
- Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeZorzi* and *Rosenberger*, in view of McClelland et al, U.S. Pat. No. 6,710,708 (hereinafter *McClelland*); and
- Claims 8-17 and 24-26 are allowed.

First, Applicant would like to thank the Examiner for the indication of allowance of claims 8-17 and 24-26. However, Applicant respectfully traverses the rejections of claims 1-7 and 18-23 and requests reconsideration in light of the arguments presented below. Claims 1-26 remain pending in this application.

II. Rejections Under 35 U.S.C. § 103

As noted, claims 1, 2, 4-6, 19 and 21-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *DeZorzi*, in view of *Rosenberger*; claims 3 and 7 stand rejected as being unpatentable over *DeZorzi* and *Rosenberger*, in further view of *Hughes*; and claim 20 stands rejected as being unpatentable over *DeZorzi* and *Rosenberger*, in further view of *McClelland*.

As a preliminary matter Applicant wishes to point out that *McClelland* and the present application are commonly assigned to Schrader-Bridgeport International, Inc. and were both owned by, or at least subject to an obligation of assignment to Schrader-Bridgeport International, Inc. at the time the invention was made. Further, whereas *McClelland* only qualifies as prior art under 35 USC 102(e) (i.e. was co-pending with the present application), Applicant respectfully asserts *McClelland* is disqualified as prior art pursuant to the provisions of 35 USC §103(c), that the rejection of claim 20 reciting *McClelland* is improper and that the rejection of claim 20 should be withdrawn.

Applicant respectfully traverses the remaining rejections for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without conceding the second criterion, Applicant respectfully asserts that the rejection fails to satisfy the first and third criteria.

A. The cited references fail to teach or suggest all elements of the claims

Independent claims 1 and 18 each recite a “shock sensor.” The Office Action admits that *DeZorzi* fails to teach or suggest use of a shock sensor. The Office Action attempts to cure this deficiency by introducing *Rosenberger*. However, the Office Action only alleges that *Rosenberger* teaches the use of a motion sensor (5a). The Office Action never asserts that *Rosenberger* teaches use of a shock sensor, and in fact *Rosenberger* does not teach or suggest the use of a shock sensor. In its entirety, the discussion of motion sensor (5a) in *Rosenberger* merely states:

A motion sensor 5a will detect any motion caused by wheel rotation or wheel removal. The analog electrical signal from the motion sensor is digitized by an analog to digital converter (A/D) 6 and sent to the vehicle digital processor 7 .

Applicant wishes to again point-out to the Examiner that a shock sensor and a motion sensor or detector are not analogous. A shock sensor detects a change in acceleration or force.

Rosenberger is silent concerning the measurement of such factors. The differences and advantages of shock sensors over accelerometers (motion sensors or detectors) is discussed at length in paragraph 49, and elsewhere, in the present application. Regardless, one of ordinary skill in the art would appreciate that motion sensors and shock sensors are not analogous and would not view *Rosenberger* as teaching the use of a shock sensor. Hence, Applicant respectfully asserts that for at least this reason the combination of *DeZorzi* and *Rosenberger* fails to teach all elements of independent claims 1 and 18. Thus, claims 1 and 18 are patentable over the 35 U.S.C. § 103 rejections of record.

Claims 2 and 4-6, each ultimately depend from independent claim 1 and thereby inherit all elements of claim 1, while claims 19 and 21-23 each ultimately depend from independent claim 18 and thereby inherit all elements of claim 18. Therefore, for at least the reasons advanced above in addressing the obviousness rejections of claims 1 and 18, each of claims 2, 4-6, 19 and 21-23 set forth features and elements not taught or suggested by the combination of *DeZorzi* and *Rosenberger*. Hence, Applicant respectfully asserts that for this reason claims 2, 4-6, 19 and 21-23 are also patentable over the 35 U.S.C. § 103 rejections of record.

As noted above, claims 3 and 7 stand rejected as being unpatentable over *DeZorzi* and *Rosenberger*, in view of *Hughes*. However, *Hughes* is not relied on by the Office Action as teaching the shock sensors missing from the combination of *DeZorzi* and *Rosenberger*, nor does *Hughes* teach the use of such a shock sensor. Whereas claims 3 and 7 each ultimately depend from independent claim 1 and thereby inherit all elements of independent claim 1, Applicant respectfully asserts that claims 3 and 7 are also patentable over the 35 U.S.C. § 103 rejections of record.

B. The Office Action does not provide the requisite motivation.

In addressing claims 1 and 18, the Office Action admits that *DeZorzi* does not teach a shock sensor. The Office Action attempts to cure this deficiency by introducing *Rosenberger*. The motivation for making the modification was presented as follows:

Since the motion detector of *DeZorzi* and the sensor of *Rosenberger* are used for sensing and producing a motion signal indicating motion of the tire monitor or the wheel containing the monitor, and since analog motion sensor is more accuracy, it would have been obvious to one of ordinary skilled in the art of vehicle monitoring to substitute the motion sensor of *DeZorzi* by

the motion sensor as taught by Rosenberger in the tire monitor of DeZorzi for sensing and producing an analog motion signal indicating motion of the tire monitor or wheel containing the monitor.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. Applicant respectfully asserts that, at best, the above-quoted language from the Office Action could only be viewed as a mere statement that the references can be combined. Given that *DeZorzi* does not rely on the accuracy of a motion signal, and only on the presences or absence of such a signal, Applicant respectfully asserts that the stated motivation to combine *DeZorzi* and *Rosenberger* is insufficient.

Further, in addressing claim 3, the Office Action incorporates *Hughes* into the combination of *DeZorzi* and *Rosenberger* by merely stating: “it would have been obvious to one of ordinary skilled in the art to use conditioning electronics as taught by *Hughes* for receiving an analog motion signal for amplifying and filtering to obtain desired signals before converting conditioned signals to digital data for latter processing or analyzing.” This is clearly only a statement that the references can be combined, and clearly fails to state any desirability for combining the references.

The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the combination. Therefore, the rejection of the claims indicated as unpatentable over *DeZorzi* and *Rosenberger* (and *Hughes*) should be withdrawn.

III. Conclusion

For all the reasons given above, Applicant submits that the pending claims distinguish over the prior art of record under 35 U.S.C. § 103. Accordingly, Applicant submits that this application is in condition for full allowance.

The fees necessary for the accompanying RCE and Petition for Extension of Time (three-months) are dealt with in the accompanying transmittals and/or the RCE and Petition itself. Applicant believes no additionally fees are due with this response. However, if an additional fee is due, please charge Deposit Account No. 50-1534, from which the undersigned is authorized to draw.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

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Respectfully submitted,



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